Paper No. 14

UNITED STATES PATENT AND TRADEMARK OFFICE

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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

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Ex parte RONALD W. RICHARDSON JR. and JAMES HARRINGTON

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Appeal No. 2000-0075
Application 08/969,941

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ON BRIEF

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Before ABRAMS, FRANKFORT, and STAAB, Administrative Patent Judges.

FRANKFORT, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the examiner's second rejection of claims 1 through 32 and 54 through 58. Claims 33 through 53 have been withdrawn from further consideration under 37 CFR § 1.142(b). Claims 59 through 99, 104 and 105

have been canceled. Claims 100 through 103, the only other claims pending in this application, have no rejection against them and appear to have never been examined by the examiner.[1] In the examiner's answer (page 3), the examiner has not listed the Wang et al. Patent (5,577,364) as being relied upon in the rejection of claims under appeal. In addition, the examiner has not repeated the rejections of claims 23 through 25 and 30 through 32 under 35 U.S.C. § 103 or the rejection of claims 26 and 27 under 35 U.S.C. § 103 as set forth in the Office action mailed June 8, 1999 (Paper No. 7). Instead, the examiner merely lists claims 23 through 27 and 30 through 32 on page 2 of the examiner's answer as "objected to." Given the examiner's failure to repeat the rejections of claims 23

[1] In reviewing the record of this application, we note that unexamined claims 100 through 103 are directed to an apparatus for charging a closed metallic canister with a gas under pressure and that claims 33 through 43 (which are part of the claims subject to the examiner's restriction requirement) are likewise directed to such an apparatus. Given that the claims before us on appeal are also directed to an apparatus for charging a closed metallic canister with a gas under pressure, it appears that claims 33 through 43 and 100 through 103 are not patentably distinct from claims 1 through 32 and 54 through 58 that are before us on appeal. The issue of the proper status of claims 33 through 43 and 100 through 103 should be resolved during any further prosecution of this application before the examiner.

through 27 and 30 through 32 in the examiner's answer, it is our conclusion that these rejections have been withdrawn by the examiner and are thus not to be considered in this appeal. See Ex parte Emm, 118 USPQ 180 (Bd. App. 1957). Accordingly, only the rejections of claims 1 through 22, 28, 29 and 54 through 58 under 35 U.S.C. § 103 remain for our consideration in this appeal.

As is set forth on page 1 of the specification, appellants' invention is directed to an apparatus for charging a canister of the type used in inflatable restraining systems for vehicles with an inert gas under high pressure and then sealing such canister. Independent claims 1 and 54 are representative of the subject matter on appeal and a copy of those claims, as reproduced from the Appendix to appellants' brief, is attached to this decision.

The prior art references of record relied upon by the examiner in rejecting the appealed claims are:

Bethell et al. (Bethell) 4,712,353 Dec. 15, 1987

Richardson 5,352,860 Oct. 4, 1994

Fukuda 05-167235 Jul. 2, 1993
(Published Japanese Patent Application)[2]

Claims 1 through 19, 22, 28, 29 and 54 through 58 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Richardson in view of Bethell.

Claims 20 and 21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Richardson in view of Bethell as applied above, and further in view of Fukuda.

[2] Our understanding of this foreign language document is based on a translation prepared for the U.S. Patent and Trademark Office. For appellants' convenience, a copy of that translation is attached to this decision.

Rather than attempt to reiterate the examiner's full commentary with regard to the above-noted rejections and the conflicting viewpoints advanced by the examiner and appellants regarding the rejections, we make reference to the Office actions mailed February 12, 1999 (Paper No. 5), June 8, 1999 (Paper No. 7) and to the examiner's answer (Paper No. 10, mailed August 26, 1999) for the reasoning in support of the rejections, and to appellants' brief (Paper No. 9, filed June 17, 1999) and reply brief (Paper No. 11, filed September 7, 1999) for the arguments thereagainst.

OPINION

In reaching our decision in this appeal, we have given careful consideration to appellants' specification and claims, to the applied prior art references, and to the respective positions articulated by appellants and the examiner. As a consequence of our review, we have made the determinations which follow.

Before addressing the examiner's rejections based on prior art, it is essential that the claimed subject matter be fully understood. Accordingly, we initially direct our attention to appellants' independent claims 1 and 54 on appeal in an attempt to derive an understanding of the scope and content thereof.

Claim 1 sets forth a third means disposed at the second station for forming an opening in a wall portion of the canister and a fourth means disposed at the third station for sequentially injecting gas under pressure into the canister through the above-noted opening, and then depositing and fusing a fusible body in the charging opening of the canister to close the opening while maintaining the gas injected into the canister under pressure. The last clause of claim 1 goes on to set forth that the fourth means includes

> means utilizing the force exerted by said gas under pressure for urging a contact portion of said third means into sealing engagement with said canister during the gas injecting, fusible body depositing and fusible body fusing, in closing said gas filling opening.

The last clause of independent claim 54 includes similar language to that in the last clause of claim 1 regarding "said third means."

Our problem with the language highlighted above in the last clause of claims 1 and 54 is that it appears to be inconsistent with the invention as described in appellants' specification. On page 20 of the specification, a portion of the fourth means at the third station is described as including an upper chamber (154), seen in Figures 14 and 16, that is supplied with the same gas under pressure that is supplied to the canister, which gas acts on the head section (153) of piston member (151) to apply an additional force on the piston member, enhancing the force applied by spring (161) and thereby urging the end of piston rod section (152) into greater sealing engagement with the canister being charged. Thus, it appears that the reference to "said third means" in the last clause of both claims 1 and 54 on appeal is in error and results in these claims, and the claims which depend therefrom, actually defining something other than that which

appellants regard as their invention. Accordingly, it is our view that claims 1 through 32 and 54 through 58 run afoul of the requirements of 35 U.S.C. § 112, second paragraph, which specifies that the claims presented must particularly point out and distinctly claim the subject matter "which the applicant regards as his invention."

Given the foregoing, under the provisions of 37 CFR § 1.196(b), we enter the following new ground of rejection against appellants' claims 1 through 32 and 54 through 58:

Claims 1 through 32 and 54 through 58 are rejected under 35 U.S.C. § 112, second paragraph, for the reasons explained above, as being indefinite for failing to particularly point out and distinctly claim that which appellants regard as their invention. In particular, we note that there is no structure described in appellants' specification that corresponds to the "means utilizing the force. . ." as currently set forth in claims 1 and 54 on appeal. Thus, the scope and content of that "means" clause in claims 1 and 54 is entirely

indeterminate.

Turning to the examiner's rejections of the appealed claims under 35 U.S.C. § 103, we emphasis again that the claims on appeal contain language which renders the subject matter thereof indefinite. Accordingly, we find that it is not reasonably possible to apply the prior art relied upon by the examiner to these claims in deciding the question of obviousness under § 103 without resorting to considerable speculation and conjecture as to the meaning of the questioned limitation in the last clause of claims 1 and 54, particularly since appellants' specification provides no guidance as to what the additional "means utilizing the force. . ." is intended to be as far as urging a contact portion of "said third means" into sealing engagement with the canister during charging of the gas and closing of the gas filling opening. This being the case, we are constrained to reverse the examiner's rejections of the appealed claims in light of the holding in In re Steele, 305 F.2d 859, 862, 134 USPQ 292, 295 (CCPA 1962). We hasten to add that this reversal of the

examiner's rejections is not based on the merits of the rejections, but on technical grounds relating to the indefiniteness of the appealed claims.[3]

In summary, the examiner's rejections of claims 1 through 22, 28, 29 and 54 through 58 under 35 U.S.C. § 103 have been reversed. A new rejection of claims 1 through 32 and 54 through 58 under 35 U.S.C. § 112, second paragraph, has been added pursuant to 37 CFR § 1.196(b).

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[3] As mere guidance to the examiner and appellants, we note that it does not appear that the Richardson and Bethell patents applied by the examiner disclose or teach an additional means like that disclosed by appellants for utilizing the force exerted by the gas under pressure for urging a contact portion of the fourth means into sealing engagement with the canister during charging of the gas and sealing of the gas filling opening. During any further examination of this application before the examiner, the examiner should treat the various "means" clauses of the claims presented by appellants in accordance with Sections 2181-2184 of the Manual of Patent Examining Procedure. For appellants' part, it should be noted that a general argument (e.g., as at brief, page 21) that the examiner has not properly interpreted "the claimed invention claimed under a means plus function format" (i.e., in accordance with 35 U.S.C. § 112, sixth paragraph), without specifically pointing out what means clause or clauses are not found in the applied prior art and why appellants believe this to be so, fails to comply with the requirements of 37 CFR § 1.192(c)(iv).

Accordingly, the decision of the examiner is reversed.

This decision contains a new ground of rejection pursuant to 37 CFR § 1.196(b). 37 CFR § 1.196(b) provides that, "A new ground of rejection shall not be considered final for purposes of judicial review."

37 CFR § 1.196(b) also provides that the appellant, WITHIN TWO MONTHS FROM THE DATE OF THE DECISION, must exercise one of the following two options with respect to the new ground of rejection to avoid termination of proceedings (§ 1.197(c)) as to the rejected claims:

(1) Submit an appropriate amendment of the claims so rejected or a showing of facts relating to the claims so rejected, or both, and have the matter

> reconsidered by the examiner, in which event the application will be remanded to the examiner. . . .
>
> (2) Request that the application be reheard under § 1.197(b) by the Board of Patent Appeals and Interferences upon the same record. . . .

No time period for taking any subsequent action in connection with this appeal may be extended under 37 CFR § 1.136(a).

REVERSED, 37 CFR § 1.196(b)

NEAL A. ABRAMS Administrative Patent Judge	)
CHARLES E. FRANKFORT Administrative Patent Judge	) BOARD OF PATENT) APPEALS AND) INTERFERENCES
LAWRENCE J. STAAB Administrative Patent Judge	)

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APPENDIX

1. An apparatus for charging a closed metallic canister with a gas under pressure comprising;

support means having a first cannister loading and unloading station and second and third stations;

at least one means disposed on said support means for removably retaining said canister in a predetermined orientation;

second means for advancing said canister retaining means sequentially to said stations;

third means disposed at said second station for forming an opening in a wall portion of

said canister positioned at said second station; and

fourth means disposed at said third station for sequentially injecting said gas under pressure through said opening into said canister positioned at said third station, and then depositing and fusing a fusible body in said opening to close said opening while maintaining said gas injected into said canister under pressure, including means utilizing the force exerted by said gas under pressure for urging a contact portion of said third means into sealing engagement with said canister during the gas injecting, fusible body depositing and fusible body fusing, in closing said gas gilling opening.

54. An apparatus for charging a closed metallic canister having a cylindrical body portion

and a rounded shoulder portion with a gas under pressure comprising;

support means having a first canister loading and unloading station and second and third stations;

at least one means for removable retaining said canister in a predetermined orientation;

means for advancing said canister retaining means sequentially to said stations;

means disposed at said second station for forming an opening in said rounded wall portion of said canister positioned at said second station including a piercing tool displaceable along a line of travel penetrating said rounded wall portion, said piercing tool having an end configuration a d length of penetrating stroke to form an opening having diverging configuration providing a lower annular support surface for receiving and retaining a fusible body; and

means disposed at said third station for sequentially injecting said gas under pressure through said opening into said canister positioned at said third station, and then depositing and fusing a fusible body in said opening to close said opening while maintaining said gas injected into said canister under pressure, including means utilizing the force exerted by said gas under pressure for urging a contact portion of said third means into sealing engagement with said canister during the gas injecting, fusible body depositing and fusible body fusing, in closing said gas filling opening.